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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,976	05/22/2001	David Pacifici	A32137A	1995

7590 10/24/2003

BAKER BOTTS LLP  
30 ROCKEFELLER PLAZA  
44th FLOOR  
NEW YORK, NY 10112-4498

EXAMINER
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CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 10/24/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/862,976

Applicant(s)

PACIFICI, DAVID

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 recites the limitation "said first and second sheets" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg et al. ('481) in view of Hanson et al. ('324).

Holmberg et al. disclose a method of irreversibly binding a plurality of sheets together comprising superimposing a sheet (10) having an adhesive strip comprising an adhesive element (14 -adhesive/glue) and a protective strip (16) releasably placed on the glue and having at least a portion (16b) not coupled to the glue (as seen in figure 4), such that the uncoupled portion may be used to grasp the protective strip during its removal over a second sheet (see col. 2, lines 52-58); grasping the uncoupled portion of the strip and pulling the uncoupled portion of the strip so as to uncover the glue and thereby irreversibly bind the two sheets together (see col. 2, lines 52-62).

Regarding the strip being pulled from the sheets while the sheets are superimposed, the sheets of Holmberg are intended to be bound to an underlying surface by removing the protective strip to expose the adhesive portion. Inherently, the sheets are superimposed in order to form the bound-together booklet.

Holmberg et al. disclose the claimed invention except for explicitly disclosing the strip being made of a silicone material. Silicone release liners are widely used for providing a protective covering over adhesives/glues. Hanson et al. disclose a method and sheet for binding pages comprising a sheet (30) having an edge (32) and a coating of pressure sensitive adhesive (34). A coating (35) of low adhesion (silicone) material is coated on the sheet adjacent the adhesive to provide a protective covering for the adhesive until the sheet is to be used. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holmberg's invention by providing the protective strip being made of a silicone material, as taught by Hanson et al., to provide a protective covering that is comprised of low adhesion material enabling easy removal of the protective covering from the glue.

Regarding claim 19, see the above rejections.

Regarding claim 20, Holmberg et al., as modified by Hanson et al., disclose the claimed invention except for the plurality of sheets being bound to at least one sheet not having an adhesive strip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to bind the sheets having adhesive strips to sheets not having adhesive strips, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as

before involves only routine skill in the art. In re Karlson, 136 USPQ 184. Even though the sheet to be bound with the remaining sheets which have adhesive strips does not, itself, include an adhesive strip, the sheet would continue to be able to be bound to the assembly as the non-adhesive sheet would adhere to the adhesive strip on the sheets comprising adhesive strips.

Regarding claim 21, Holmberg et al., as modified by Hanson et al., disclose the claimed invention except for sheet being capable of being used in a loose-leaf ring binder providing a binding cover.

### ***Response to Arguments***

5. Applicant's arguments filed September 15, 2003 have been fully considered but they are not persuasive.

Applicant argues that neither Holmberg nor Hanson, either alone or in combination, disclose or suggest that a silicone band may be removed while the sheets are superimposed. Applicant further argues that since the ribbon 16 is within the boundaries of each sheet 10, this configuration provides no means for accessing the ribbon 16 while another sheet has been superimposed over the ribbon 16. The examiner disagrees. Holmberg discloses paper sheets that are processed through normal printing, copying and die stamping operations and then the sheets are stacked. The stacked sheets provide a pressure-sensitive glued edge with a suitable protective strip overlying the adhesive portion with both the adhesive and the strip being received in a predetermined groove providing a uniform thickness of the sheet. The sheet provides an

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attachment portion along a marginal edge when the protective strip is removed (as seen in figures 6 and 7). The protective strip can be removed from the sheet while the sheets are superimposed by bending the sheet located directly above the sheet to enable the protective strip to be removed. The examiner therefore maintains that Holmberg does disclose removing the band while the sheets are superimposed.

It is noted the Hanson has been used to solely disclose the band being made of a silicone material and has not been relied upon for disclosing any of the other claimed limitations.

For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**

October 23, 2003